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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,340	02/06/2006	Tadahiro Hiramoto	Q87742	9312

65565 7590 11/28/2007

SUGHRUE-265550
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EXAMINER	
GEORGE, KONATA M	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/533,340	HIRAMOTO ET AL.	
	Examiner	Art Unit	
	Konata M. George	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-9,11,12,14-18,21 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-9,11,12,14-18,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-3, 5-9, 11, 12, 14-18, 21 and 22 are pending in this application.

Request for Continued Examination (RCE)

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 9, 2007 has been entered.

Action Summary

2. The examiner acknowledges the cancellation of claims 13, 19 and 20. Therefore, any and all objections and/or rejections directed to them are hereby withdrawn.

3. The rejection of claims 1-3, 5-9, 11, 12, 14-18, 21 and 22 under 35 U.S.C. 103(a) as being unpatentable over Echigo et al. in view of Yamashita et al. is being maintained for the reasons stated in the office action dated June 8, 2007.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-3, 5-9, 11, 12, 14-18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Echigo et al. (US 6,537,546) in view of Yamashita et al. (US 6,780,403).

Applicants claim a deodorant composition comprising a lignin, a phenolic compound-oxidizing enzyme and a fragrance and/or flavor.

Determination of the scope and content of the prior art

(MPEP §2141.01)

Echigo et al. disclose in column 3, lines 9-14, mixing phenolic compounds with enzymes having a polyphenol oxidizing activity. Column 3, lines 18-22 teach examples

of the enzyme and lines 53-57 teach the phenolic compound as a lignin and examples thereof. Column 4, lines 16-21 teach the use of the composition as a deodorant or as smell eliminators.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

Echigo et al. do not teach the addition of a fragrance or a flavor in the composition. It is for this that Yamashita et al. is joined.

Yamashita et al. disclose a deodorant composition which comprises a perfume (col. 5, line 66 through col. 6, line 44).

Finding of prima facie obviousness

***Rational and Motivation* (MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Yamashita et al. with the invention of Echigo et al. Yamashita et al. is relied upon to teach that perfumes are known ingredients to be added to deodorants. Since Echigo et al. teach that the composition can be used as a deodorant, adding a perfume to the composition would have been obvious to one of ordinary skill in the art.

Response to Arguments

5. Applicant's arguments filed October 9, 2007 have been fully considered but they are not persuasive.

Applicant has amended the claims to recite that the enzyme can exhibit the desired deodorizing effect when the lignin is present. It is the position of the examiner that this recitation is functional language and as such carries no patentable weight.

Applicant argues that Echigo et al. disclose a process of increasing the molecular weight of phenolic compounds by allowing polyphenol-oxidizing enzymes to act on phenolic compounds so that the phenolic compounds can be used as a deodorant. As stated in the office action, column 4, lines 16-21 teach that the macromolecularized phenolic compounds can be used as a deodorant. Column 3, lines 9-14 teach that macromolcularizing comprises allowing an enzyme having a polyphenol oxidizing activity to act on a phenolic compound. Therefore, it is the position of the examiner that the deodorant compositions of Echigo et al. will contain the enzyme and the phenolic compound, which is the same as claimed by applicant and is thus obvious.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3, 5-9, 11, 12, 14-18, 21 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 20, 23, 34, 41, 44 and 45 of copending Application No. 10/410,520. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are direct to a deodorant composition comprising a phenolic compound, a phenolic compound-oxidizing enzyme and a fragrance or flavor. The difference between the copending applications is that in application '520 the composition is specific to the types of fragrances and flavors used. It is the position of the examiner that since the instant invention is silent with respect to the specific fragrances and flavors then any and all fragrances and flavors can be used, even those listed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. Claims 1-3, 5-9, 11, 12, 14-18, 21 and 22 remain rejected.

Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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